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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,272	09/30/2003	Andrew R. Ferlitsch	SLA1319	6569

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EXAMINER	
BLAIR, DOUGLAS B	

ART UNIT	PAPER NUMBER
2442	

NOTIFICATION DATE	DELIVERY MODE
03/25/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

usptocorrespondence@austin-rapp.com

Office Action Summary	Application No.	Applicant(s)	
	10/676,272	FERLITSCH, ANDREW R.	
	Examiner	Art Unit	
	DOUGLAS B. BLAIR	2442	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 February 2010*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

The applicant has amended claims 1, 3, 4, 9-12, and 17-20 and added new claim 35. Claims 1-35 are currently pending.

Response to Arguments

Applicant's arguments filed 2/24/2010 have been fully considered but they are not persuasive.

The applicant's argument that Kemp does not satisfy the claimed determination is not persuasive because the limitation itself is extremely broad and not claimed in any sequential context. Clicking on one of the links in Fig. 6 of Kemp satisfies the applicant's broadly claimed "determination". The applicant alleges that in claim 1 "determining" occurs before the peripheral device is formally "address[ed]... using the determined network address". This allegation is not correct because though the "determining" is recited before the "formal addressing" in the claim, the plain language of the claim itself is only a method with actions that are not limited to any sequence.

Likewise, "determining the network address of the peripheral device by the client device in response to the creation of the print job" in the applicant's claim does not mean that all of the claimed actions of determining happen only after the print job is created. The claimed "determination" only requires that the determination "included" the claimed actions recited later in the claim. In Figure 6 of Kemp the claimed actions could have occurred prior but a determination of an address would still be required to actually send the print job off.

The Examiner acknowledges differences in what the applicant is trying to claim and the applied prior art but the claims do not adequately reflect these differences.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 35 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 35 recites the limitation "retrieving the second data file from the server device" in the body of the claim. There is no "second data file" previously mentioned anywhere prior in the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, 9-11, 17-19, 25-27, 31, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 7,213,060 to Kemp et al. in view of U.S. Patent Number 6,032,162 to Burke.

As to claim 1, Kemp teaches a method for communicating between a client device and a peripheral device over a network that includes the peripheral device (Ref. numbers 40-42 in Figure 1), the client device (Ref. numbers 20 and 21), and a server device (Ref. number 51) adapted to control the peripheral device, the peripheral device having a network address which is not known to the client device, wherein the method if performed by the client device, the method comprising: creating a print job, the print job is to be sent to the peripheral device (col. 4, lines 24-39); determining a network address of the peripheral device in response to the creation of a print job that is to be sent to the peripheral device (col. 4, lines 24-39, the process of installing the printer information from the website happens after the print job is submitted), and, wherein the determining includes: retrieving a first data file from the server device, wherein the first data file is a web page (Figure 6); identifying one or more portions of the retrieved first data file as potential network addresses (Figure 6 shows network addresses); identifying one or more potential network addresses of the retrieved fist data file as network addresses (Figure 6); and determining if a network address is the network address of the peripheral device (Figure 6), wherein determining includes sending a communication over the network (col. 2, lines 30-47, by using the device, a "determination" is made. The claims are directed towards a method that is not limited to an sequence of events); addressing the peripheral device using the determined network address of the peripheral device (col. 2, lines 30-47); and communicating directly with the peripheral device, thereby bypassing the server device (col. 2, lines 30-47); however Kemp does not explicitly teach the method including comparing the one or more potential network addresses of the retrieved first data file with predetermined data formatting pattern indicative of a network address.

Burke teaches a method of comparing one or more potential network addresses of a retrieved data file with a predetermined data formatting pattern indicative of a network address (col. 4, line 55-col. 5, line 7) where the comparison includes metatags (the HTML), text blocks (the text between tags), and sub-routines (col. 7, line 47, the web pages have Java just as discloses by the applicant).

It would have been obvious to one of ordinary skill in the Computer networking art at the time of the invention to combine the teachings of Kemp regarding using a web page to find peripherals with the teachings of Burke regarding the recognition of address formats because the teachings of Burke are broad enough to apply to the application taught by Kemp (See Burke, col. 8, lines 35-46).

As to claims 2 and 3, these limitations are taught by the cited portion of Burke.

Claims 9-11 and 17-19 are rejected for the same reasons claims 1-3.

Claims 4-8, 12-16, 18-24, and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 7,213,060 to Kemp et al. in view of U.S. Patent Number 6,032,162 to Burke. in further view of U.S. Patent Application Publication Number 2002/0059489 by Davis et al.

As to claim 4, the Kemp-Burke combination teaches the method of claim 1; however the Kemp-Burke combination does not teach the redundancy of having a file with an address to another file.

Davis teaches an addressable data file containing a list of printers including their addresses (paragraph 31).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of the Kemp-Burke combination regarding the addressing of printers with the teachings of Davis regarding an addressable data file that contains printer addresses because a data file containing printer addresses allows for a central location for maintaining printer data.

As to claims 5-8, the Kemp-Burke combination makes obvious recognizing an address as discussed and testing as claimed in that once the user tries to use the address, the user will be "testing" it.

Claims 12-16 and 18-24 are rejected for the same reasons as claims 4-8.

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 7,213,060 to Kemp et al. in view of U.S. Patent Number 6,032,162 to Burke in further view of U.S. Patent Number 7,168,003 to Lozano et al

As to claim 33, the Kemp-Burke combination teaches the subject matter of claim 1 however the Kemp-Burke combination does not explicitly teach the peripheral.

Lazano teaches pinging the peripheral to ensure operation (col. 9, lines 38-54).

It would have been obvious to one of ordinary skill in the Computer networking art at the time of the invention to combine the teachings of the Kemp-Burke combination regarding address discovery with the teachings of Simpson regarding pinging the peripheral to ensure operation because pinging can identify non-operational devices

Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 7,213,060 to Kemp et al. in view of U.S. Patent Number 6,032,162 to Burke in further view of U.S. Patent Application Publication number 2003/0055874 by Simpson.

As to claim 34, the Kemp-Burke combination teaches the subject matter of claim 1 however the Kemp-Burke combination does not explicitly teach issuing an SNMP query to the peripheral.

Simpson teaches the a discovery method to discover which address are printers by using SNMP queries (paragraph 38).

It would have been obvious to one of ordinary skill in the Computer networking art at the time of the invention to combine the teachings of the Kemp-Burke combination regarding address discovery with the teachings of Simpson regarding device type discovery because SNMP can confirm the type of devices found on a network (Simpson paragraph 38).

Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 7,213,060 to Kemp et al. in view of U.S. Patent Number 6,032,162 to Burke in further view of U.S. Patent Application Publication number 2003/0055874 by Simpson and U.S. Patent Number 7,168,003 to Lozano et al.

As to claim 35, it is rejected for the same reasoning as claims 1, 33, and 34. It would be obvious to perform the same method on a "second" data file because the claims do not relate the processing of the "first" data file to the "second" data file in any manner. Kemp is clearly not related to just one web page. If the applicant was trying to claim something along the lines of claim 4, such a claim is not patentable for the reason discussed in the rejection of claim 4.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOUGLAS B. BLAIR whose telephone number is (571)272-3893. The examiner can normally be reached on 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571) 272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Douglas B Blair/
Primary Examiner, Art Unit 2442